

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Application Number	09/965,808
Filing Date	October 1, 2001
First Named Inventor	Michael POCOCK
Art Unit	2623
Examiner Name	Rueben M. Brown
Attorney Docket No.	69250.000002

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this appeal.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided

I am the:

Applicant/Inventor

Raymond B. Persino

Signature

Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96).

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Registration No. if acting under 37 CFR 1.34 _____

May 14, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

PATENT
Attorney Docket No.: 69250.000002
Application No. 09/965,808

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number	:	09/965,808	Confirmation No.:	3641
Applicant	:	Michael Pocock		
Filed	:	October 1, 2001		
Title	:	Apparatus and Method to Generate and Access Broadcast Information		
TC/Art Unit	:	2623		
Examiner:	:	Rueben M. Brown		
Docket No.	:	69250.000002		
Customer No.	:	21967		

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Sir:

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Program, Applicant hereby requests a pre-appeal brief conference in the above-referenced case.

Claims 1-17, 19-21 and 23-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,539,635 issued to Larson, Jr. (hereafter LARSON) in view of U.S. Patent No. 5,136,636 issued to Wegrzynowicz (hereafter WEG).

Regarding claim 1, Applicant respectfully submits that the Examiner's obviousness determination is based on impermissible hindsight reconstruction, and not on the objective teachings of LARSON and WEG. Furthermore, Applicant submits that even if one were to combine LARSON and WEG, the resulting combination would not arrive at the present invention.

The particular combination of LARSON and WEG implemented by the Examiner is a modification of LARSON per WEG to include a technique for sorting broadcasters based on their geographical location. As motivation for the combination, the Examiner has asserted that the combination would have been obvious for "the improvement of allowing customer's to dial a single '1-800' number, but to access providers that are local to the customer." Applicant agrees

that WEG provides the above motivation but respectfully disagrees that it motivates the particular combination set forth by the Examiner. In particular, WEG does not in any way teach a technique for sorting broadcasters based on their geographical location or area of broadcast signal. Instead, WEG is concerned with the routing of a customer's telephone call to one of a plurality of local providers' telephone numbers. In WEG, customer's use their telephone to dial a toll-free telephone number that is common to all of the participating providers (dealers). Further, each provider has their own telephone number that services the customer's location. Accordingly, Applicant asserts that one of ordinary skill in the art would not combine LARSON and WEG to arrive at the Applicant's claim 1 without using hindsight reconstruction.

"When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." Id. at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)). In the present case, if one considers LARSON and WEG as a whole, the resulting combination becomes clear. Based on WEG's teaching, one of ordinary skill in the art would at best be motivated to apply WEG in a scenario in which it is desired to use a single telephone number to route a call to one of a plurality of local providers that each have their own telephone number. The only portion of LARSON related to the dialing of a telephone number is a consumer's dialing of a broadcast program distribution system's telephone number to purchase a particular broadcast program that was heard while listening to a broadcast signal. In the context of WEG, LARSON's broadcast program distribution system is nothing more than a service provider with a telephone number. Therefore, the modification of LARSON per WEG would at best yield a system in which consumers are given a "1-800" number to be routed to one of a plurality of broadcast program distribution systems, each having their own telephone number.

The above combination of LARSON and WEG significantly differs from that set forth in the Examiner's combination. Instead, the Examiner's combination appears to be a combination of select portions of LARSON and WEG that are divorced from their teaching and suspiciously fit together so as to formulate something that resembles the Applicant's claim 1. In picking out and combining the chosen portions of LARSON and WEG, the Examiner has not given any indication or suggestion as to how or why the particular portions are selected by the Examiner to be detached from their respective teachings. Furthermore, the Examiner has not identified or suggested how one might blend all of the various concepts in LARSON and WEG. Accordingly, it is clear that the Examiner's combination fails to consider the objective teachings of the prior art as a whole and instead uses the Applicant's teaching as a roadmap for picking and choosing isolated elements from LARSON and WEG to formulate something that resembles the Applicant's claim 1. Therefore, it is clear that the Examiner's combination can only be based on impermissible hindsight reconstruction.

Moreover, Applicant respectfully submits that the Examiner's rejection of claim 1 fails to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. At the least, the Examiner has failed to establish a *prima facie* case of obviousness by not providing a prior art reference (or references when combined) that teach or suggests all the claim

limitations. In particular, the combination of LARSON and WEG fails to teach or suggest the following features recited in claim 1:

communicating said user related geographic identification code into said database to create a subset of data, said subset of data comprising data representing at least one broadcast identifier

There is no teaching or suggestion in either LARSON or WEG for the above identified features of communicating a user related geographic identification code into a database to create a subset of data. This issue has been previously addressed by both Applicant and the Examiner. For example, on page 7 of the final rejection, the Examiner has asserted that the above subject matter is taught by WEG which teaches “that based on the ANI of the calling party (which reads on claimed geographical ID), the system connects the customer to the database that contains providers that correspond to the customer's geographical area.” In other words, the above cited portion of WEG teaches routing the customer to a second database that contains dealers in the same local area as the instant customer. However, in the amendment filed August 23, 2006 and again herein, Applicant's submit that WEG's routing function is not a teaching or suggestion of creating a subset of data.

In particular, the function of WEG's primary database is to route the caller information to a secondary database that contains telephone numbers relating to “a dealer in the same local area” as the caller. The initial look-up by the primary database does not “create a subset of data” but rather uses NPA (caller's telephone area and exchange code) to **look-up** “a number for identifying the secondary database” (WEG Col. 2, lines 49-53) it should also be noted that this number is not a telephone number. Further, the primary database does not create the number for identifying the secondary database. Instead, the primary database looks-up and provides the number for identifying the secondary database. Therefore, at best, WEG's primary database looks up information that is used for routing instead of creating a subset of data.

In response to the above argument presented in the amendment filed August 23, 2006, the Examiner on page 3 of the final rejection has identified a different element in WEG that allegedly teaches the above subject matter. In the final rejection, the Examiner has argued that when the caller's NPA is received, the “DSD 150 database” (secondary database)...” uses the routing number to find a segment of its database that contains the required translation information.” (Col. 5, lines 20-30). In other words, the Examiner is arguing that finding an item of information in a database corresponds to creating a subset of data. However, this portion of WEG fails to teach creating a subset of data for the same reasons presented above with respect to the primary database. Thus, even if WEG's secondary database were considered, there is no “subset of data created.” Therefore, contrary to the Examiner's allegation, WEG does not teach “communicating said user related geographic identification code into said database to create a subset of data, said subset of data comprising data representing at least one broadcast identifier.”

Additionally, Applicant respectfully submits that the Examiner's combination of LARSON and WEG fails to teach or suggest the following features recited in claim 1:

**identifying said radio or television broadcast from said
subset of data upon receipt of said broadcast identifier**

There is no teaching or suggestion in either LARSON or WEG for the above identified feature. This issue has been previously addressed by the Applicant on pages 7 and 8 of the amendment filed August 23, 2006. The Examiner is encouraged to reconsider the previously submitted arguments in addition to the arguments presented below.

The Examiner alleges that the Applicant's above identified feature is taught by LARSON. In particular, the Examiner is interpreting LARSON's selection of a database entry, for a Broadcast ID entered by a consumer, as reading on the Applicant's above identified feature. However, in LARSON, the selection of a database entry, for a Broadcast ID entered by a consumer, is nothing more than a matching function and is not in any way an identification function. In particular, the Broadcast ID that is entered by the consumer is representative of a particular broadcast station *already known to the consumer*. The broadcast program distribution system receives the Broadcast ID that is entered by the consumer, along with time and date information, to find database entries associated with the Broadcast ID. Since the Broadcast ID entered by the consumer already fully represents a particular broadcast station, an identification function does not need to be performed. Therefore, contrary to the Examiner's allegation, LARSON does not teach an identification function, let alone "identifying said radio or television broadcast from said subset of data upon receipt of said broadcast identifier."

Accordingly, for any of the reasons presented above, claim 1 is allowable over the cited references and withdrawal of the rejection is earnestly solicited. Since claims 2-17 depend from claim 1, and since LARSON and WEG do not disclose all of the limitations of claim 1, Applicant submits that claims 2-17 are patentable at least by virtue of their dependency from claim 1.

Independent claim 19 includes certain features and operations that are analogous to those discussed above with regard to claim 1, which Applicants have shown to be allowable. Further, issues related to claim 19 have been previously addressed by the Applicant on pages 10 and 11 of the amendment filed August 23, 2006. The Examiner is encouraged to reconsider the previously submitted arguments. Accordingly, Applicants submit that claim 19 is allowable over the cited references and withdrawal of the rejection is earnestly solicited.

Regarding claim 20, Applicant respectfully submits that for the same reasons as those presented above with respect to claim 1, the Examiner's obviousness determination is based on impermissible hindsight reconstruction and not the objective teachings of LARSON and WEG. Applicant further submits that the Examiner's combination of LARSON and WEG fails to teach or suggest:

an input receiving a geographic identification code and a broadcast identifier, said geographic identification code and said broadcast identifier related to a user inquiry

*a second input identifying a radio or television broadcast
from said subset of broadcast identifiers*

In the rejection of claim 20, it is asserted that the ‘first’ input corresponds with the subject matter of claim 1 and is likewise treated. The rejection further asserts that the processor, which includes the second input, reads on the combination of the Request Processing Unit 10 of LARSON and the OSO/ACP 110 of WEG. Applicant respectfully traverses and submits that LARSON and WEG, neither alone nor in combination, teaches or suggests the claimed ‘first’ and second input. Even if it were conceded (which concession is not made) that the combination of LARSON and WEG teaches the ‘first’ input, this would not be sufficient to establish that the second input is taught or suggested. From claim 1, it is believed that the Examiner is drawing upon the combination of the receipt of the broadcaster in LARSON and the receipt of the NPA of the calling station from WEG, as suggesting the ‘first’ input. Also from claim 1, the Examiner is suggesting that the radio or television broadcast is identified from a subset of data upon receipt of said broadcast identifier. However, in claim 20, the receipt of the broadcast identifier is included in the ‘first’ input. Accordingly, there is nothing in claim 1 that is analogous to the second input identifying a radio or television broadcast from said subset of broadcast identifiers. Moreover, the Examiner has not identified any portion of either LARSON or WEG that teaches or suggests the feature of “a second input identifying a radio or television broadcast from said subset of broadcast identifiers”, when the ‘first’ input receives a geographic identification code and a broadcast identifier. Accordingly, for the reasons presented above, claim 20 is allowable over the cited references and withdrawal of the rejection is earnestly solicited. Since claims 21 and 23-27 depend from claim 20, and since LARSON and WEG do not disclose all of the limitations of claim 20, Applicant submits that claims 21 and 23-27 are patentable at least by virtue of their dependency from claim 20.

Because reversal of the pending rejections is likely, Applicants respectfully request that the cost of appeal be avoided by withdrawing the above rejections.

Dated: May 14, 2007

Respectfully submitted,

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